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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,431	06/29/2001	Richard Qian	42390P11146	8957

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BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER	
CHEN, TE Y	
ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,431

Applicant(s)

QIAN, RICHARD

Examiner

Susan Y. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 106-121 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 106-121 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

This office action is in response to the amendment filed on 4/17/2006, wherein, as admitted by applicant, claims 87-89 have never been presented in the instant application; claims that have been canceled are 1-86 and 90-105; and claims 106-121 have been newly added.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 106-121, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 106 and 111, these claims language extensively use the term "wherein" but the instant specification fails to provide actual steps to perform or limit these claims to a particular structure, thus, this term renders the claimed scope to be indistinct. See *In re Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (en banc), off 'd, U.S., 116 Ct. 1384 (1996).

As to claim 107-110 and 112-121, these claims have the same defects as their base claims, thus, are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 106-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr et al. (U.S. Patent No. 6,386,451) in view of Sezan et al. (U.S. Patent No. 6,236,395).

As to claims 106, 111 and 120, Sehr discloses an apparatus comprising:
a portable medium such as a smart card with embedded microprocessor and a storage medium [e.g., the multi-application passenger (or smart) card 11 at col. 6, lines 19-41, Fig. 3 and associated texts];

user preference information for media consumption stored in the storage medium [e.g., the downloaded points of interest stored into a passenger card at col. 39, lines 51-53], wherein the user preference information includes at least a television preference and a web browsing preference [e.g., the use of global communication link or Internet allows the associated components of a card station (Fig. 1) to interact with each other and thus support the multimedia platform audio, graphics and video, etc data exchange without any restrictions at col. 6, lines 42 – col. 7, line 26 & col. 29, lines 44-48].

a template database stored in the storage medium that including a plurality of user preference templates that each correspond to a different type of electronic entertainment device, wherein each of the plurality of user preference templates is to identify user preferences for media consumption on one of the different types of electronic entertainment device [e.g., the distributed database including template files at col. 5, lines 15-26, the card template database at col. 17, lines 7-36, col. 29, lines 44-58, col. 39, lines 51-53].

Sehr did not specifically discloses the plurality of user preference templates includes a first user preference template that is compatible with a television and a second user preference template that is compatible with a computer having a web browser.

However, Sezan et al. (hereinafter referred as Sezan) discloses an audiovisual data management system [e.g., the unit 16, Fig. 1] with the claimed features, comprising: An audiovisual program analysis modules [e.g., the unit 42, Fig. 2] coupled to a data storage unit [e.g., the data storage unit 50, Fig. 2] that stores a plurality of user preference templates identified by user description scheme [e.g., the unit 20, Fig. 1 and associated texts], wherein the user description scheme, system description scheme and program description schema are configured to allow a portable medium [e.g., a smart card, col. 6, line 6] to communicate with a plurality of devices that correspond to various templates including the claimed compatible television and a web browser templates as

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recited by applicant via use's preference information stored in the schemes [e.g., Fig(s). 1-12 and associated texts; col. 5, lines 37 – col. 6, line 20, col. 9, lines 1-25; col. 9, line 34 – col. 10, line 56].

Sehr and Sezan are in the same field of endeavor to optimize the portable device such as smart card processing, therefore, with the teachings of Sehr and Sezan in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the well known technique as disclosed by Sezan into Sehr portable device processing system, because by doing so as suggested by Sezan, the combined will be upgraded to use a combination of the description schemes to enhance its ability to search, filter and browse audiovisual information in a personalized and effective manner for different devices with different templates [e.g., Sezan: col. 45, lines 25 – 61].

As to claims 107 and 113, except the features disclosed on claims 106 and 111, the combined system of Sehr and Sezan further discloses a template to store manually entered user preferences for a device [e.g., Sezan: the unit: 48, Fig. 1 and associated texts] and a different template to store user preference determined from usage history for the device [e.g., Sezan: the unit: 52, Fig. 1 and associated texts].

As to claims 108 and 114, except the features disclosed on claims 106 and 111, the combined system of Sehr and Sezan further discloses the user preference

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information is prioritized based on whether it was manually entered or determined through usage history [e.g., Sezan: col. 11, lines 54-67].

As to claims 109 and 115, except the features disclosed on claims 106 and 111, the combined system of Sehr and Sezan further discloses the user preference data is stored in an extensible markup language format [e.g., Sezan: the web pages information format, col. 5, lines 22-32].

As to claims 110 and 112, except the features disclosed on claims 106 and 111, the combined system further discloses the system having logic circuit to dynamically update the user preference information based on user activity [e.g., Sezan: col. 5, lines 66 – col. 6, line 12].

As to claims 116-117, except the features disclosed on claim 111, the combined system further discloses the instruction stored on the machine-readable medium database that if executed cause the logic circuit to generate a template, wherein the template database is stored on the machine-readable medium [e.g., Sehr: col. 17, lines 7-45].

As to claim 118, except the features disclosed on claim 111, the combined system further discloses that the template database comprises an identification template and history template [e.g., Sehr: col. 18, lines 65 – col. 19, line 5].

As to claim 119, except the features disclosed on claim 111, the combined system further discloses that the template database comprises a user history template [e.g., Sehr: the Status Window, Fig. 3].

As to claim 121, except the features disclosed on claim 111, the combined system further discloses the machine-readable medium having flash memory [e.g., Sehr: the memory of claim 2, col. 45].

Response to Arguments

Applicant's arguments filed on 4/17/2006 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, the Office points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, the examiner notices that applicant fails to define the metes and bounds of the claimed subject matter: "media consumption" or "type of electronic entertainment device", thus, they are open for art interpretation.

In addition, as cited in the above paragraphs, Sehr specifically discloses user preference templates to identify user preference for media consumption on different types of electronic devices regardless of the type of devices. For example, please refer to the distributed database including template files at col. 5, lines 15-26, the card template database at col. 17, lines 7-36, col. 29, lines 44-58 and col. 39, lines 51-53 as cited by Sehr, therefore, in contrary to applicant arguments, Sehr, clearly teaches a smart card that is not only used for travel related services such as audio, graphics, video, etc data from various multi-media entertainment devices, but also, stored user preference information for media consumption [e.g., col. 29, lines 51 – 55].

Moreover, Sezan further clearly discloses various system, program and user description schemas that provides the details to learn from a user via direct input of preferences or by watching the usage pattern and history of the user stored in these description schemas and acts on behalf of the user to discover programs that fits the taste of the user in a VCR image processing or web page multi-media program viewing environment [e.g., Sezan, col. 11, lines 51-67, col. 12, line 28-65].

Therefore, one of ordinary skill in the art at the time the invention was made would in fact, contrary to applicant's arguments, look to incorporate the description schema technique as taught by Sezan in Sehr's system to enhance its ability to search, filter and browse audiovisual information in a personalized and effective manner for different devices with different templates, as such, the examiner contends that there would be most definitely a reasonable expectation of success.

Base on the discussion above, the examiner clearly fulfills a prima facie case of obviousness set forth in MPEP Section 706.02(j).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen
Examiner
Art Unit 2161

June 28, 2006



UYEN LE
PRIMARY EXAMINER